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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 *Ex parte* FABIO PERINI
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13 Appeal No. 2009-008646
14 Application No. 10/524,001
15 Technology Center 3700
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18 Oral Hearing Held: March 16, 2010
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22 Before JENNIFER D. BAHR, JOHN C. KERINS, and
23 STEVEN D.A. MCCARTHY, *Administrative Patent Judges*.
24

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1 THE CLERK: Good morning. Calendar Number 51, Appeal Number 2009-
2 008646, Mr. Duncan.

3 JUDGE BAHR: Thank you.

4 Good morning, Mr. Duncan.

5 MR. DUNCAN: Hello.

6 JUDGE BAHR: You may begin whenever you're ready.

7 MR. DUNCAN: Basically, what the present invention relates to is an
8 apparatus that produces small paper logs.

9 There's a particular problem in the prior art that rewinding machines produce
10 cores that have wound material on them that usually leave a portion of the
11 core without winding material. In other words, a portion of the core extends
12 from an end of the winding material. What happens is when these logs are
13 divided -- or rolls -- they produce, basically, rolls that don't have uniform
14 lengths of wound material.

15 Basically, the Appellant has solved this problem by providing a particular
16 arrangement of a rewinding machine, a trimming device, and a trimmed-roll
17 store element, and a cutting-off device.

18 The particular arrangement allows for rolls that are produced from the
19 rewinder to be -- at least one end of them -- to be cut by the trimming
20 device, and then fed to the trimmed-roll store element wherein the cutting
21 off machine then further subdivides the trimmed rolls.

22 Basically, what this does is allows for uniform length, a uniform portion of
23 core with a uniform wound material thereon.

24 The prior art, as a whole, really doesn't teach any of this. Basically, the prior
25 art suggests each one of them -- and even taken as a whole -- each of the

1 pieces of prior art suggest just providing whole logs, or whole metal tubes in
2 the case of Friden, in which the logs are just subdivided; and no further
3 processing takes place.

4 So, basically, for example, for Gambaro it discloses an infeed conveyor 12
5 that has a holding means 18 thereon that each holding means receives a log
6 in its entirety. There is no pretrimmed logs fed to the infeed conveyor, and
7 each log in its entirety is then fed to a sprocket where the cutting means cuts
8 the logs while it's in the sprocket to provide a plurality of trimmed or cut
9 logs. But there's no further processing after the logs are cut into a plurality
10 of smaller logs.

11 You know, basically, what the Appellant feels is a novel feature is the
12 specific arrangement of the rewinding machine, the trimming device, and the
13 store element and cutting-off machine.

14 Even in Gambaro it doesn't suggest or teach a specific rewinding machine.

15 Specifically, Gambaro relates to just wet logs that are supposedly cut.

16 There's no mention that the wet logs are paper rolls that are formed from a
17 rewinding machine.

18 Even in Nystrand -- it basically discloses the same idea as Gambaro where
19 just logs are fed to an orbital saw, and then the logs are cut into a plurality of
20 smaller logs.

21 Again, there's no trimming device in between the rewinding machine and the
22 orbital saw, and there's no teaching or suggestion for the specific problem of,
23 you know, having a core projecting from an end of a wound material.

1 Further on, there's nothing in Nystrand that particularly suggests that even
2 after the rolls are then cut that they are further processed and further
3 subdivided, as featured in Appellant's invention.

4 Further on --

5 JUDGE MCCARTHY: Counsel, why wouldn't, for example, Claim 1 be
6 broad enough to cover the apparatus, which includes a trimming device and
7 the cutting-off machine, combined into a single unit?

8 MR. DUNCAN: Well, the prior art has to have some sort of suggestion or
9 teaching that would, obviously, make that obvious.

10 From our position, there is no teaching in either Gambaro, Nystrand, or
11 Friden that would make it obvious to provide a trimming device in between
12 the rewinder of Nystrand or before --

13 JUDGE MCCARTHY: Actually, Counsel, I was asking a question of claim
14 interpretation.

15 MR. DUNCAN: Sure.

16 JUDGE MCCARTHY: Why Claim 1 would not be broad enough to include
17 an apparatus that includes both the trimming function and the cutting-off
18 function performed by a single unit or a single device within the apparatus.

19 MR. DUNCAN: So your question is why you can't have one device that
20 trims and cuts logs?

21 JUDGE MCCARTHY: Yes.

22 MR. DUNCAN: Well, you have to have -- it's the all elements rule. You
23 have to have two devices: a trimming device, and then the cutting-off
24 machine. Because in between the trimming device is the roll store element
25 that stores the logs and then feeds the pretrimmed logs to the cutting-off

1 machine.

2 So in other words, you have to have three things -- really, you have to have
3 four things: you have to have a rewinding machine, you have to have the
4 trimming device, you have to have the store element, as well as the cutting-
5 off machine.

6 This doesn't relate to just a single piece that does all four of those functions.
7 Have I answered your question?

8 JUDGE MCCARTHY: (Nodding affirmatively.)

9 MR. DUNCAN: Okay.

10 Basically, the final rejection would have you believe that Friden would make
11 it obvious to provide the trimming device of Friden in between the
12 rewinding machine of Nystrand and the infeed conveyor of Gambaro.

13 However, if you take a close look at Friden, what Friden really discloses is
14 just metal tubes wherein one end is just cut off. So, basically, what Friden is
15 dealing with is just cutting off whole logs, which are really metal tubes,
16 which is pretty much the same as Gambaro and Nystrand.

17 Why would a person of ordinary skill in the art be directed to Friden since it
18 has nothing to do with forming paper material, or particularly paper logs, as
19 featured in the present invention and as dealt with in Nystrand and Gambaro
20 --

21 JUDGE KERINS: Counselor, are you saying that it's nonanalogous art?

22 MR. DUNCAN: Yes, that's correct.

23 JUDGE KERINS: Did you argue that in the Briefs here?

24 MR. DUNCAN: Well, what we argued in the Appeal Brief is why would
25 you look at Friden when Nystrand and Gambaro already disclose cutting-off

1 devices?

2 I mean, what makes it about Friden that it would be obvious to combine the
3 teachings of Friden with Nystrand and Gambaro?

4 JUDGE KERINS: Because it teaches trimming the ends of the rolls.

5 MR. DUNCAN: Well, if you take a look at the specific teaching of Friden,
6 it specifically relates to metal tubes. It has nothing to do with the art of, you
7 know, cutting off -- the problem of cutting off paper rolls wherein the
8 specific problem is the core projects from the end of the wound material.

9 In addition, even if a person of ordinary skill in the art were to be directed to
10 Friden, it doesn't provide any teaching or suggestion for further subdividing
11 the metal tubes after one end of the metal tubes have been trimmed.

12 JUDGE KERINS: Right, Counsel, but isn't the Examiner's position that
13 Friden teaches the trimmer, and you would install a trimmer at the front end
14 or between a rewinder and a cutting device in either of the other references?

15 MR. DUNCAN: Right, you are correct. That is the Examiner's position.
16 However, it's just not about cutting off an end of, you know, a particular
17 object, in this case paper rolls -- or in the case of Friden, metal tubes -- it's
18 the whole combination of the arrangement.

19 Meaning the rewinding machine, the trimming device, and the trimmed-roll
20 store element and the cutting-off machine. Friden provides no teaching or
21 suggestion of specifically providing its trimming device before the infeed
22 conveyor of Gambaro or in between the rewinding device of Nystrand and
23 orbital saw of Nystrand.

24 There's just no particular teaching or suggestion that would direct a person
25 already skilled in the arts to do so.

1 JUDGE KERINS: Well, you had said the logs that are produced have
2 irregular ends.

3 MR. DUNCAN: Correct.

4 JUDGE KERINS: And I believe in your defined specification it describes
5 trimming in prior art systems they would trim the end, similar to what's done
6 in Nystrand. The arrangement was similar to Nystrand, and the end would
7 be trimmed as the log first went to the cutters.

8 MR. DUNCAN: Right, but Nystrand doesn't particularly deal with the
9 problem of cutting off the ends of -- you know, the irregular end of the paper
10 roll.

11 Basically, what Nystrand is concerned with is a particular sequence which
12 prevents log jamming. In other words, as the logs are moved, they're moved
13 in such a way that the logs are cut, and then moved so the logs don't get,
14 basically, backed up.

15 JUDGE KERINS: But Nystrand does disclose trimming the end as it's
16 coming in.

17 MR. DUNCAN: I would take the position that Nystrand discloses trimming
18 each individual log into a plurality of smaller logs because that's essentially
19 what they're doing. They're taking entire whole logs, shipping them toward
20 the orbital saw and then cutting each log, basically, at the same time.

21 JUDGE KERINS: Counselor, at Column 5 about line 10 of Nystrand, it
22 refers to the severed log rolls and trimmed portions. That would be Column
23 5, lines 11 and 12.

24 MR. DUNCAN: Yes, where it says and trim portions as they issue from the
25 lanes 35 through 38.

1 JUDGE KERINS: And then further on it talks about the thin trim rolls,
2 which are developed or discarded, and he calls them cookies.

3 MR. DUNCAN: Correct.

4 JUDGE KERINS: So there is a trimming at either the front or back end.

5 MR. DUNCAN: Right. If you're going to say Nystrand trims the logs, then
6 I guess, you know, you can take that position. But the bottom line is,
7 Nystrand doesn't disclose anything about further subdividing those logs, as
8 featured in the present invention.

9 JUDGE KERINS: Counsel, it teaches putting the log in and trimming the
10 front end, and then cutting rolls after that.

11 MR. DUNCAN: I would have to disagree with that because, basically, what
12 Nystrand does is that it trims the logs; but then there's no further trimming
13 after that point.

14 After they're cut by the orbital saw, there is no further subdivision of the
15 logs. In fact --

16 JUDGE KERINS: Well, the log is the original unit that's cut into rolls.

17 MR. DUNCAN: I would have to disagree because if you look at Nystrand,
18 Nystrand transports whole logs in their entirety. There is no trimming.

19 JUDGE KERINS: Correct, and it turns them into severed log rolls with trim
20 portions.

21 MR. DUNCAN: What they're talking about specifically with the trim
22 portions, from my understanding of Nystrand, is the trim portions are,
23 basically, portions of the logs that were, you know, miscut or whatever
24 because they talk about how these cookies -- you know, when they're
25 transferred through and discharged after being cut, the cookies somehow fall

1 through the discharge means.

2 That's my understanding of Nystrand. I don't see it as, you know, a
3 pretrimming and then sending it to the orbital saw and further subdividing.

4 JUDGE KERINS: The trimming is done by the orbital saw.

5 MR. DUNCAN: Well, the orbital saw cuts the logs, which are received in
6 their entirety.

7 JUDGE KERINS: In any event, given that it is known that the original logs
8 will have at least one irregular end with the core sticking out or the core
9 sticking in, something that wasn't brought up by the Examiner or the
10 Appellant was how does this fit in with what we have in the way of KSR
11 precedent?

12 It seems like all we have -- you've got a known problem at the end of the
13 rolls that are irregular. So why is it not that it would be obvious to put a
14 trimmer in to eliminate that irregular roll --

15 MR. DUNCAN: Then you'd have -- I'm sorry, I didn't mean to cut you off.

16 JUDGE KERINS: It seems the Examiner has put together something that
17 would have predictable results.

18 MR. DUNCAN: I'd have to disagree with that because you have to take a
19 look at the prior art in its entirety.

20 Particularly with Friden, Friden doesn't mention anything about pretrimming
21 paper rolls. I mean, there's just nothing -- no teaching whatsoever -- about
22 receiving paper rolls from a rewinding machine, cutting them and then
23 further subdividing them with a cutting-off machine.

24 JUDGE KERINS: But the Examiner doesn't rely on Friden as teaching all
25 of that. It relies on Friden as teaching trimming irregular ends of a product.

1 MR. DUNCAN: Right, but my position is even if it does teach trimming an
2 end, there is no teaching or suggestion for receiving paper rolls, trimming
3 the end of it, and then further subdividing it with a cutting off machine.

4 Basically, you have to have the whole arrangement. The whole arrangement
5 is not disclosed or suggested.

6 There's no teaching or suggestion in Friden of specifically putting it after a
7 rewinding machine, in between a trimmed-roll store element. There's
8 definitely no teaching or suggestion of having the cutting machine receiving
9 already pretrimmed paper rolls, which is completely void in each one of
10 these references.

11 JUDGE KERINS: Counsel, I will agree Friden doesn't teach all that. I
12 guess my point is it sounds very much like you're attacking references
13 individually and not looking at the combination of the teachings.

14 MR. DUNCAN: Well, I've looked at the combination but there has to be
15 some sort of a teaching or suggestion for that combination. What the
16 Examiner relies on in the final rejection is, specifically, Friden to teach that
17 combination.

18 Our position is --

19 JUDGE KERINS: No, the Examiner relies on Friden as teaching trimming
20 ends of rolls. Trimming irregular ends of products, not paper rolls, not
21 conveying them to further be cut. Simply, trimming irregular ends of
22 products.

23 MR. DUNCAN: Right, and our position is how does that fit in with the
24 other two references?

25 JUDGE KERINS: Well, you acknowledge in the specification that there's a

1 problem with the prior art in that the ends are irregular.

2 MR. DUNCAN: Right, each one of these references specifically teach just
3 sending an entire log and cutting it, but no further processing whatsoever.
4 So how does the prior art teach that? You know, Gambaro, Nystrand and
5 Friden they all teach whole logs -- or in the case of Friden, metal tubes --
6 that are cut, and then that's it. There is no further processing or anything
7 else that is claimed in the arrangement of the first independent claim.

8 JUDGE KERINS: Well, in the Examiner's combination, either with
9 Gambaro or Nystrand, he's saying it's obvious to put a trimmer, such as in
10 Friden, at the front stage of these things. So all the other processing is done
11 by what's taught in the other references.

12 MR. DUNCAN: Well, again, I go back to there has to be some motivation,
13 some direction that would lead the person of ordinary skill to do that.
14 In this case, there is no direction or motivation for a person of ordinary skill
15 to do that. Friden is specifically directed to cutting off an end of a whole
16 tube, and there is no teaching or suggestion of further providing that to a
17 further cutting-off means to further subdivide it.

18 I mean, I think that's a pretty fair interpretation of not only Friden but the
19 references as a whole.

20 JUDGE MCCARTHY: I think, Counsel, what I'd be looking at here is that
21 Friden teaches you have to deal with irregular ends of -- in the case of Friden
22 -- tubes, but tubes are obviously of similar shape to logs.
23 Gambaro or Nystrand are teaching that you need to cut the log into pieces.
24 If you're to combine the two, the trimmer of Friden would be doing the same
25 thing in combination with a log cutter as it would be doing separately.

1 The log cutter of Gambaro or Nystrand would be doing the same thing, in
2 combination with Friden, that they would be doing separately.
3 It seems to me what we have is simply an aggregation of two different
4 devices that are being put together to simply perform the same thing together
5 that they would do separately.

6 Therefore, that in itself, is the apparent reason for combining the elements in
7 the fashion claimed.

8 MR. DUNCAN: Well, I have to disagree with that. Again, as I said,
9 basically each of these references don't provide any further teaching of
10 further processing --

11 JUDGE MCCARTHY: But KSR says the combination of familiar elements
12 according to known methods is likely to be obvious when it does no more
13 than produce a predictable result. It doesn't say if they perform the same
14 thing that you need an additional reason to combine them.

15 MR. DUNCAN: Well, I think it doesn't produce predictable results because,
16 first of all, none of these prior art references specifically deal with the
17 problem of irregularities of, you know, paper rolls, wherein the core projects
18 from -- which is specific to the paper art -- where the core projects from an
19 end of the wound material. Because what you have happen is once you
20 further subdivide those, you end up with a core that has a minimal amount of
21 wound material on it.

22 So what the conventional techniques used to have to do is you have to find
23 all these pieces and sift through them. You know, further individually cut
24 through them.

25 So I don't think that what we're doing produces some predictable result

1 because none of the prior art references specifically address our particular
2 problem, which deals particularly with forming rolls from a rewinding
3 machine.

4 You know, I've spoken about the independent claim and why it's not
5 obvious. I'd also like to point to some of the other dependent claims,
6 particularly Claim 6, where basically the final rejection takes the position
7 that the base 12 of Friden is the equivalent of the roll moving means for
8 moving the roll between the entry section and trimming device and an exit
9 section.

10 But if you look at Claim 6, what you have is you have the roll transfer means
11 includes a body that is mounted on a shaft. Now, the position taken by the
12 final rejection is not known. Basically, what you have is the final rejection
13 takes the position that the base 12 of Friden is the equivalent of a roll-
14 moving means.

15 However, the base 12 doesn't move. Essentially, what base 12 is it's
16 elements that are mounted onto the base 12.

17 The Final Rejection further takes the position that, basically, steps 11 are the
18 equivalent of the body of the present invention. However the steps 11 of
19 Friden are not mounted on a shaft as claimed.

20 Basically, what the point of Claim 6 is if you look at the drawings, which is
21 particularly if you look at Figure 5A of Appellant's specification, the roll
22 transfer means 5 is, basically, mounted on a shaft so it can pivot and then
23 deliver logs or rolls to the log-moving means so the logs can further be
24 trimmed and then provided to the exit section.

25 Again, there's no teaching or suggestion of the features of Claim 6. Again,

1 the Examiner doesn't specifically point out where the shaft in Friden is.

2 JUDGE KERINS: Counsel, the Examiner says that the screws in the side of
3 the body 6 of Friden are the shaft.

4 MR. DUNCAN: I'd have to respectfully disagree with that. I don't view that
5 as a shaft, and I don't view how the steps 11 are, you know, mounted to a
6 shaft that's parallel to the entry section of the rolls.

7 JUDGE KERINS: It says the body is mounted to the shaft.

8 MR. DUNCAN: Right.

9 JUDGE KERINS: The body is element 6, and I don't see anything in Claim
10 6 that restricts the body to something that would necessarily exclude element
11 6 here.

12 MR. DUNCAN: Well, I don't see how element 6 is mounted to any sort of
13 shaft. I mean how does that --

14 JUDGE KERINS: Again, Counsel, you made the statement that the
15 Examiner hadn't identified what he regards as the shaft. Well, he did.

16 MR. DUNCAN: Right.

17 JUDGE KERINS: He said the screws mounting that body to the --

18 MR. DUNCAN: So the Examiner's position is the steps 11 are mounted to
19 the movable screws?

20 JUDGE KERINS: The entire body 6 --

21 MR. DUNCAN: Right.

22 JUDGE KERINS: -- is mounted to shafts, which are the screws 8. I'm
23 sorry, they're not 8. The screws shown at the upper right-hand part of the
24 body.

25 MR. DUNCAN: I'm going to have to respectfully disagree with that

1 because, basically, in my interpretation of the Final Rejection, the Examiner
2 takes the position that the body is the steps 11, and that the steps 11 are
3 mounted onto a movable shaft.

4 JUDGE KERINS: Counsel, it says it should be noted -- this is page 5 of the
5 Examiner's answer. It should be noted that the screws that mount the body
6 to the plate is considered to be a shaft and the plurality of seats defined by
7 the steps formed in the body.

8 MR. DUNCAN: Well, I guess if that's the position that's taken, then I don't
9 see how that moves any -- you know, any rolls to the actual sprocket.

10 I mean, the whole point of the present invention is that, you know, being
11 mounted to the shaft it's movable about the shaft so that it can further move
12 the logs from the transfer means to the actual log roll means that allows the
13 log to be moved and trimmed and then sent to the exit section of the
14 trimming device.

15 JUDGE KERINS: That's your disclosed invention, but it's not your claimed
16 invention.

17 MR. DUNCAN: Well, I still take the position that, you know, the steps 11
18 aren't mounted to a shaft as claimed. I think that's a fair interpretation of
19 Friden.

20 You know, if you want to say that somehow the screw mounts, you know,
21 the steps 11 to a shaft that's parallel to the entry section of the logs, I think
22 that's an unfair interpretation.

23 Even so, if you look at Claim 4, Claim 4 particularly claims that grippers
24 clamp the paper rolls. Now, a person of ordinary skill in the art -- I know

1 the Final Rejection relies on Friden to disclose, basically, a clamping means
2 which is 22.

3 However, Gambaro makes it clear that the logs shouldn't be clamped.

4 Basically, in Paragraph 72 in Gambaro, it basically discloses that
5 deformation of the rolls should be avoided, and that particularly the rolls
6 should not be clamped during cutting.

7 The interpretation taken by the Examiner by relying on Friden is inconsistent
8 because Friden basically discloses that the logs are clamped, but that's not
9 consistent with the teaching of Gambaro.

10 Gambaro particularly discloses that the rolls or logs should not be clamped
11 because they unduly deform the logs themselves, particularly since Gambaro
12 deals with wet logs; and it's pretty much common knowledge that anything
13 that's wet and you clamp it, it's going to be deformed.

14 JUDGE KERINS: Counsel, I apologize -- what paragraph was that in
15 Gambaro?

16 MR. DUNCAN: 72 in Gambaro.

17 JUDGE KERINS: Thank you.

18 MR. DUNCAN: Further, Claims 25 and 26 further provide for the further
19 arrangement of the trimming device and the specific arrangement of the trim
20 block store element; and, basically, provides that Claim 25, you know, the
21 trimming devices arranged upstream of the store element.

22 Again, the particular arrangement and particular limitations of the exact
23 placement of the trimming device is not disclosed by the prior art in its
24 entirety.

1 I think I'm running out of time so, basically, for the reasons discussed here
2 and the arguments mentioned in the Appellant's previously filed Appeal
3 Brief and Reply Brief, it is requested that the Examiner's rejection be
4 reversed.

5 Any other questions?

6 JUDGE BAHR: Any others?

7 JUDGE KERINS: No.

8 JUDGE MCCARTHY: No.

9 JUDGE BAHR: I don't think we do.

10 MR. DUNCAN: Fine. Thank you for your time.

11 JUDGE BAHR: We'll take this case under advisement.

12 Whereupon, the proceedings at 9:55 a.m. were concluded.

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